

U.S. Patent Application No. 10/578,338
Attorney Docket No. 10191/4578
Response to Office Action of July 25, 2008

REMARKS

Claims 25 to 35 are added, and therefore claims 14 to 35 are now pending and being considered in the present application.

In view of the following remarks, it is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

With regard to paragraph one (1), the Office Action asserts that the information disclosure statement (IDS) filed May 5, 2006 fails to comply with 37 CFR 1.98(a)(2). It is respectfully submitted that the copies of the references need not be included since they are provided by the International Search Report, since it includes a list of documents that were considered in the underlying PCT application. Nevertheless, to facilitate matters, courtesy copies of the foreign references (previously cited and disclosed in the previously filed IDS and 1449 papers) accompany this response. It is respectfully requested that these references be considered and made of record based on the previously filed IDS and 1449 papers.

With regard to paragraph three (3), claims 13 to 16 and 18 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,208,923 (the “Hommel” reference).

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(b), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed invention, namely the claimed subject matter of the claims, as discussed herein. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics *necessarily* flows from the teachings of the applied art.” (*See M.P.E.P. § 2112*; emphasis in original; and *see Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the

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prior art does not establish the inherency of that result or characteristic. Accordingly, it is respectfully submitted that any anticipation rejection premised on the inherency doctrine is not sustainable absent the foregoing conditions.

It is respectfully submitted that the “Hommel” reference does not identically disclose (nor even suggest) the claim 13 feature of “at least two electrical units; and power supply units, each of the electrical units being assigned a respective one of power supply units, and **each being connected via at least one fuse.**” The Office Action asserts that this feature is disclosed by the “Hommel” reference. In support of this assertion, the Office Action merely points to devices 18a and 18b, which are relays. It is respectfully submitted that a fuse is not identical to a relay. A fuse is a protection device. The specification specifically discloses that the fuse protection “has the advantage that an individual fault or the switching-off of an individual component within an electrical unit does not result in the other electrical unit being switched off. It is thus ensured that at least one electrical unit is available to a torque control element for transmitting control commands.” (See *Specification*, page 3, lines 24 to 31). In contrast, a relay is a control device where a small amount of current is used to control a large amount of current. These components are absolutely not interchangeable. Therefore, the “Hommel” reference does not identically disclose (nor even suggest) the critical feature of “each being connected via at least one fuse.”

While the rejections may not be agreed with, to facilitate matters, independent claim 13 has been rewritten herein without prejudice to further obviate the present rejection. In particular, claim 13, has been rewritten to provide that the “at least two electrical units operate independently of one another.” With the process computer of the “Hommel” reference, “[i]n the event of a fault, the **process computer of one system shuts down the other system** via no-current-opening relays.” (The “Hommel” reference, column 1, lines 64 to 67 (emphasis added)). Thus, there is reciprocal influencing of the two systems. For example, a fault within one system can have an effect on the other system, and thus can affect the functioning of the entire steering system. Therefore, the electrical units don’t operate independently of one another as provided in the context of the claimed subject matter as currently presented.

For at least the foregoing reasons, claim 13, as presented, and its dependent claims 14 to 16 and 18 are allowable. It is therefore respectfully requested that the anticipation rejections be withdrawn.

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With regard to paragraph five (5), claims 13, 17, 19, 20, and 22 to 24 were rejected under 35 U.S.C. 103(a) as unpatentable over the combination of the “Hommel” reference in view of U.S. Patent No. 6,208,923 (the “Higashi” reference).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *See KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

Claim 13 is allowable for essentially the same reasons as provided in the context of the anticipation discussion because the secondary “Higashi” reference does not cure, and is not asserted to cure, the critical deficiency of the primary “Hommel” reference. It is therefore respectfully requested that the obviousness rejection for claim 13 and its dependent claim 17 be withdrawn.

Claim 19 includes features like those of claim 13 and, is therefore allowable for essentially the same reasons as claim 13 since the secondary “Higashi” reference does not cure, and is not asserted to cure, the critical deficiency of the primary “Hommel” reference. It is therefore respectfully requested that the obviousness rejection for claim 19 and its dependent claims 19, 20, and 22 to 24 be withdrawn.

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With regard to paragraph six (6), claim 21 was rejected under 35 U.S.C. 103(a) as unpatentable over the combination of the "Hommel" reference in view the "Higashi" reference and U.S. Application No. 2005/0082108 (the "Husain" reference).

Claim 21 depends from claim 19 and is therefore allowable for the same reasons as claim 19 since the "Husain" reference does not cure, and is not asserted to cure, the critical deficiencies of the "Hommel" reference and the "Higashi" reference. It is therefore respectfully requested that the obviousness rejection for claim 21 be withdrawn.

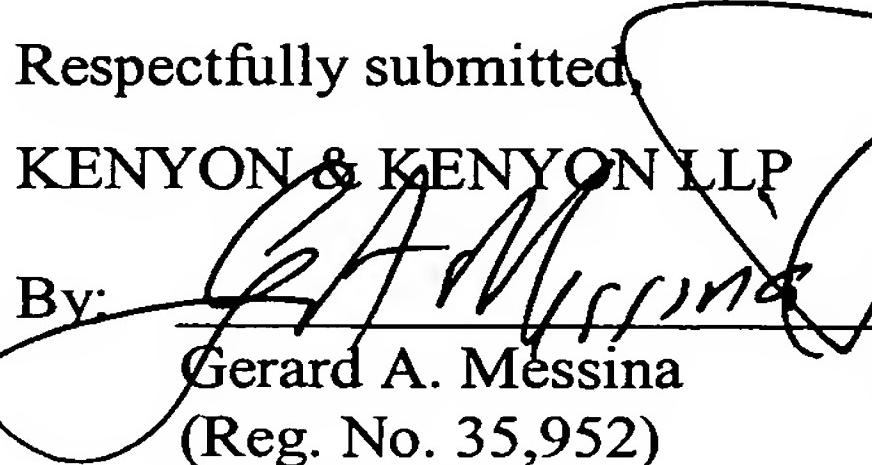
New claims 25 to 35 do not add any new matter and are supported by the present application. Claims 25 to 32 depend from claim 19 and are therefore allowable for the same reasons. Claim 33 to 35 depend from claim 13 and are therefore allowable for the same reasons.

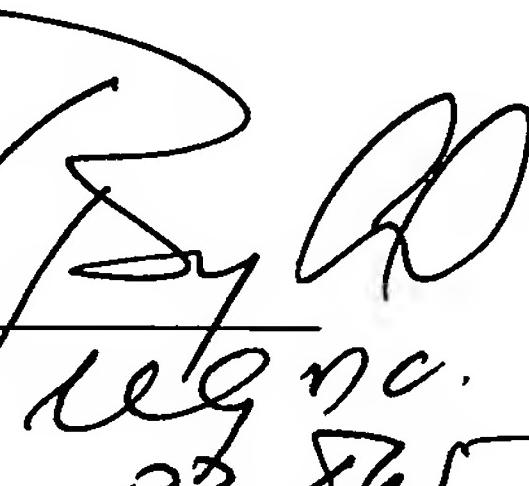
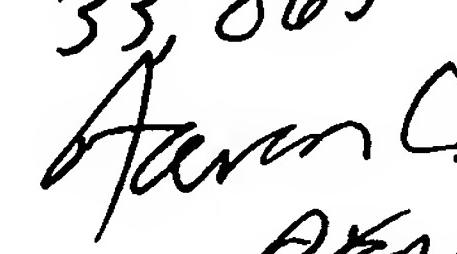
Accordingly, claims 13 to 35 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that claims 13 to 35 are allowable. It is therefore respectfully requested that the objections and rejections be withdrawn. Prompt reconsideration and allowance of the present application are therefore respectfully requested.

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Respectfully submitted,
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